

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed September 21, 2006. Through this response, claims 1, 19-22, 49, 68-71, 86-90, 98, 99, and 102 have been amended; claims 17, 18, 66, and 67 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1-16, 19-65, and 68-104 are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(e)**A. Statement of the Rejection**

Claims 1-20, 22-69, and 71-104 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by *Maissel et al.* (“*Maissel*,” U.S. Pat. No. 6,637,029). Applicants respectfully traverse these rejections, and through the above described amendments and cancellations to the claims, Applicants consider these rejections moot as to independent claims 1, 49, 98, 99, and 102, and corresponding dependent claims.

B. Discussion of the Rejection

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Maissel* reference. Applicants discuss the *Maissel* reference and Applicants’ claims in the following.

Independent Claims 1, 49, 99, and 102

Claims 1, 49, 99, and 102 recite (with emphasis added):

1. A method for providing television functionality comprising: tracking viewing parameters corresponding to services that are provided to a user; determining a user preference for a viewing parameter; tracking the user preference by assigning a score to the viewing parameter; ***determining the score for the viewing parameter based on a weighted linear combination of scores associated with the viewing parameter***; receiving user input requesting television functionality; and providing a user with a result that is responsive to the user input and to the user preference.

49. A system for providing television functionality comprising: logic for tracking viewing parameters corresponding to services that are provided to a user; logic for determining a user preference for a viewing parameter; logic for tracking the user preference by assigning a score to the viewing parameter; ***logic for determining the score for the viewing parameter based on a weighted linear combination of scores associated with the viewing parameter***; and logic for providing a user with a result that is responsive to the user input and to the user preference.

99. A method for providing television functionality comprising: tracking viewing parameters corresponding to services that are provided to a user; determining a user preference for a viewing parameter; tracking the user preference by assigning a score to the viewing parameter; ***determining the score for the viewing parameter based on a weighted linear combination of scores associated with the viewing parameter***; receiving user input requesting an interactive program guide; and providing a user with an interactive program guide that is responsive to the user input and to the user preference.

102. A method for providing television functionality comprising: tracking viewing parameters corresponding to services that are provided to a user; determining a user preference for a viewing parameter; tracking the user preference by assigning a score to the viewing parameter; ***determining the score for the viewing parameter based on a weighted linear combination of scores associated with the viewing parameter***; receiving user input requesting a television service; and providing a user with a television service that is responsive to the user input and to the user preference.

Applicants respectfully submit that the rejection of amended independent claims 1, 49, 99, and 102 and the respective dependent claims under this rejection have been rendered moot.

Further, as to the amended claims 1, 49, 99, and 102, Applicants respectfully submit that *Maissel* fails to disclose, teach, or suggest at least the above-emphasized claim features.

Because independent claims 1, 49, 99 and 102 are allowable over *Maissel*, respective dependent claims 2-16, 19-20, 22-48, 50-65, 68-69, 71-97, 100-101, and 103-104 are allowable as a matter of law for at least the reason that the dependent claims 2-16, 19-20, 22-48, 50-65, 68-69, 71-97, 100-101, and 103-104 contain all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 98

Claim 98 recites (with emphasis added):

98. A method for providing television functionality comprising: tracking viewing parameters corresponding to services that are provided to a user; determining a user preference for a viewing parameter; receiving user input requesting television functionality; and providing a user with a result that is responsive to the user input and to the user preference; where the user preference corresponds to at least one viewing parameter; where the user preference is determined based on a duration that a service characterized by a viewing parameter is presented to a user; where the user preference is determined by tracking services that are provided by a digital home communication terminal; where a preference tracking database keeps track of user preferences for a plurality of types of viewing parameters; where the user preference is tracked by assigning a score to a viewing parameter; ***determining the score for the viewing parameter based on a weighted linear combination of scores associated with the viewing parameter***; where data identifying the user preference is stored within a digital home communication terminal; where a look-up table is used to determine the user preference for a viewing parameter.

Applicants respectfully submit that the rejection of amended independent claim 98 has been rendered moot. Further, as to the amended claims 98, Applicants respectfully submit that *Maissel* fails to disclose, teach, or suggest at least the above-emphasized claim features.

Due to the shortcomings of the *Maissel* reference described in the foregoing, Applicants respectfully submit that *Maissel* does not anticipate Applicants' claim.

Therefore, Applicants respectfully request that the rejection of independent claim 98 be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 21 and 70

Claims 21 and 70 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Maissel* with a taking of Official Notice. Applicants respectfully traverse this rejection.

B. Discussion of the Rejection

The U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

Applicants submit that as provided above, amended independent claims 1 and 49 are allowable over *Maissel*. Applicants respectfully submit that the taking of Official Notice does not remedy the above-described deficiencies of *Maissel*. Thus, for at least the reasons

that dependent claims 21 and 70 incorporate the features of respective allowable amended claims 1 and 49, dependent claims 21 and 70 are allowable as a matter of law.

III. Official Notice

The Office Action has made the following allegations of Official Notice (location in the Office Action and claim relevance noted in parenthesis):

(Page 11, pertaining to claims 21 and 70) Official Notice is taken that it is notoriously well known in the art to use statistic analysis to revise obtained score of viewing parameters for the benefit of projecting future needs of TV programs concerning the like/dislike of TV programs. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Maissel to use statistic analysis for revising score of viewing parameters so to provide an accuracy on projecting future needs of TV programs to viewer concerning the like/dislike of TV program and further to better serve TV programming services in the future.

Applicants respectfully traverse these findings of well-known or Official Notice and submit that the subject matter pertaining to these claims should not be considered well-known. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

As provided in MPEP § 2144.03 (emphasis added):

If applicant adequately traverses the examiner's assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

Applicants respectfully submit that in the context of the claim language, such a finding of well known art is improper at least given the added complexity associated with such features as described in claims 21 and 70. Accordingly, Applicants traverse the assertions with regard to well-known use. Because of this traversal, the Office must support its findings with evidence, or withdraw the well-known determination.

IV. Canceled Claims

As identified above, claims 17, 18, 66, and 67 have been canceled without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/dr/

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